

Remarks

Claims 30, 42, 44, and 56 have been amended to correct a typographical error. Accordingly, no new matter has been added. Upon entry of these amendments, claims 30-57 will be pending

Provisional Election with Traverse

The Office has requested election of a single disclosed species citing that claims 30-57 are drawn to a number of allegedly patentably distinct species including Sjogren's Syndrome, Reiter's Disease, Guillain-Barre Syndrome, Hashimoto's Thyroiditis, Addison's disease, biliary cirrhosis, and asthma. *See*, Paper No. 20070329, page 2.

To comply with the pending restriction requirement, Applicants provisionally elect, *with traverse*, claims embodying the subject matter of Sjogren's Syndrome for further prosecution. As requested by the Office, Applicants submit that claims 30-42 and 44-56 are directed to subject matter falling within the ambit of the provisionally elected subject matter.

Applicants reserve the right to file one or more continuation and/or divisional applications directed to non-elected groups should the restriction requirement be made final. Applicants respectfully traverse the present election requirement.

Claims 30 and 44 Are Generic Linking Claims

As an initial matter, Applicants respectfully submit that claims 30 and 44 are Markush-type generic linking claims encompassing all of the species identified by the Office, including the present provisionally elected species. *See*, Paper No. 20070329, page 2. Hence, Applicants respectfully object to the blanket statement, rendered without explanation, that "no claim is generic." *See*, Paper No. 20070329, page 2. Moreover, the M.P.E.P. instructs that

linking claims must be examined with the invention elected, and should any linking claim be allowed, the restriction requirement must be withdrawn. Any claim(s) directed to the nonelected invention(s), previously withdrawn from consideration, which depends from or includes all the limitations of the allowable linking claim must be rejoined and will be fully examined for patentability.

M.P.E.P. § 809. *See also* M.P.E.P. § 809.03.

Moreover, a blanket statement that “no claim is generic” does not render generic claims non-generic. *See*, M.P.E.P. § 806.04(d). Accordingly, pursuant to M.P.E.P. §§ 809 – 809.03, if generic linking claim 30 or 44 are found to be allowable, all of the species linked by it must be rejoined and examined for patentability.

The Office has not shown that examination of the current claims is a serious burden

Additionally, Applicants respectfully submit that restriction remains improper unless it can be shown that the search and examination of all groups would entail a “serious burden.” *See* M.P.E.P. § 803. In the present situation, no such showing has been made. At the very least, a search of an autoimmune disease would provide useful information for the related autoimmune disease. For example, a search of Sjogren’s Syndrome would significantly overlap with searches of other autoimmune diseases including Reiter’s Disease, Guillain-Barre Syndrome, Hashimoto’s Thyroiditis, Addison’s disease, biliary cirrhosis, or asthma. Therefore, Applicants therefore respectfully request that the restriction requirement under 35 U.S.C. § 121 be reconsidered and withdrawn, and that all of the autoimmune disease species identified by the Office be examined together.

All species within a proper Markush-type claim should be examined together

Finally, the Office is respectfully reminded of *In re Weber*, 580 F.2d 455, 198 U.S.P.Q. 328 (C.C.P.A. 1978) in which the court articulated the general proposition that:

[A]n applicant has a right to have *each* claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the right of the applicant eventually to have each of the claims examined in the form he considers to best define the invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the Examiner rather than by the applicant, it is not inconceivable that a number of the fragments would not

be described in the specification. *Id.* at 331 (Emphasis in original).

In view of the above and similar case law, the Patent Office has set forth a general policy regarding the restriction of Markush-type claims in MPEP §803.02. According to the general policy as articulated in the MPEP, “since the decisions in *In re Weber*, 580 F.2d 455, 198 U.S.P.Q. 328 (C.C.P.A. 1978) and *In re Haas*, 580 F.2d 461, 198 U.S.P.Q. 334, it is improper for the Office to refuse to examine that which Applicants regard as their invention, unless the subject matter in a claim lack unity of invention. *In re Harnish*, 631 F.2d 716, 206 U.S.P.Q. 300 (C.C.P.A. 1980); and *Ex parte Hozumi*, 3 U.S.P.Q.2d 1059 (B.P.A.I. 1984).” (MPEP §803.02). Applicants respectfully submit that claims 30 and 44 are proper Markush-type claims.

Moreover, even where a provisional election of species is proper prior to examination on the merits, following election, the Markush-type claim should be examined fully with respect to the elected species and further to the extent necessary to determine patentability. (MPEP § 803.02). The MPEP requires that should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended to non-elected species. (MPEP § 803.02). Accordingly, Applicants respectfully submit that once examination of the elected species in Markush-type claims 30 and 44 is complete, and no prior art is found to anticipate or render the elected species obvious, the Office should examine all non-elected species in Markush-type claims 30 and 44.

Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

Conclusion

Applicants respectfully request that the amendments and remarks submitted herein be entered in the present application. The Examiner is invited to call the undersigned at the phone number provided below if any further action by Applicants would expedite the examination of this application.

If there are any fees not already accounted for due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136, such an extension is requested and the fee should also be charged to our Deposit Account.

Dated: May 8, 2007

Respectfully submitted,

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